

REMARKS

The Applicant is appreciative of the thorough examination made by the Examiner in this case. The present RCE is being filed in response to the Office Action dated November 1, 2006.

INTRODUCTION

It is noted that the amendments made on July 13, 2006 have been entered, that the substitute specification provided on July 13, 2006 has been entered, and that claims 24, 25, 27-32, 35 and 37-68 are now pending in the application.

With respect to the Examiner's Note on page 2 of the Office Action, submitted herewith is an English translation of the relevant portion of the Italian language paper of Carlo Leoni, together with an executed Verification of Translation. Entry of this document into the file is requested.

It is further noted that the various objections and rejections regarding the specification, drawings and claims have all been withdrawn in the light of the Applicant's amendment filed on July 13, 2006.

REJECTION UNDER 35 USC 112, second paragraph

Claims 35 and 36 have been rejected under 35 U.S.C. 112, second paragraph, as being "indefinite."

The term "starting tomato composition" does not appear in claims 33 and 34, as alleged by the Examiner. Nevertheless, claims 33 and 34 have been canceled, thereby rendering this observation moot. Claim 36 has also been cancelled.

The Examiner has questioned the recitation of "50% to 300% by weight" with regard to the amount of soft cheese recited in claim 35 and now-cancelled claim 36.

As stated on page 6, lines 3-11 of the specification, the amount of soft cheese ranging from 50% to 300% by weight is made with reference to the "weight of the starting tomato product". Thus, for example, if the starting tomato product weighs 100g, then the amount of

soft-grain cheese which can be incorporated can range from 50g (50%) to 300g (300%). The same concept is shown in Examples 6 and 7 on page 18 of the specification. Thus, reciting an amount of cheese of 50% to 300% by weight which can be added to the composition is merely a different way of reporting the amount used; note page 18, lines 5-7 from the bottom. In summary, the ratio of Rol/cheese of 25/75 is merely a different way to report the value of 300%.

The Applicant has amended claim 35 to be responsive to the Examiner's rejection. If another wording is desired, the Applicant will follow the Examiner's suggestion in this regard. Otherwise, it is believed that the explanation herein, taken together with the teachings in the specification, serve to support the language used in claim 35 in a definite and clear manner.

REJECTION UNDER 35 USC 102(b)

Claims 24-30, 33, 34 and 37 have been rejected under 35 U.S.C. 102(b) as being "anticipated" by Glasser et al, U.S. Patent 4,140,809. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

On pages 3-6 of the Office Action, the Examiner carries out calculations which lead to amounts of "... 33.3-100% soluble solids based on the dry residue in the final composition, and 0-66.6% insoluble solids based on the dry residue in the final composition"; page 6, lines 11-13 in the Office Action.

RESPONSE BY THE APPLICANT

The Applicant hereby responds as follows.

The soup concentrates described in the Glasser patent are defined as constituted of soup ingredients which are water soluble and those which are water insoluble, combined with a limited amount of water.

Lines 8-12, column 3:

"The essence of the invention resides in the discovery that conventional soup ingredients which are water soluble and those which are water insoluble when, combined with a limited amount of water in correct proportions, will cooperate to..."

The composition of soup concentrates is defined in lines 13-22 of column 4 (Glasser patent):

“However, it is essential that each soup concentrate of this invention be formulated with water solutes and water insoluble solids to the extent that the ratio of solute to insoluble solids ranges from about 2:1 to about 0.25:1. The soup concentrates, in order to fall within the province of the invention, have a total moisture content ranging from about 40% to about 60%; water solutes ranging from about 20% to about 40%; and water insoluble materials ranging from about 10% to about 40%; based on the weight of the concentrate.”

In lines 13 –22 there are some values that we will use hereinafter in order to execute two calculations (herein called A and B). Both calculations have the same final purpose: **to compare the Glasser ‘ 809 patent with the present application No. 10/524,014. This comparison will consider the content of water soluble solids (water solutes) and water insoluble solids found in 100 grams of dry residue of soup concentrates.**

Scenario A.

We will start from col. 4, lines 13-17 (Glasser patent):

“However it is essential that each soup concentrate of this invention be formulated with water solutes and water insoluble solids to the extent that the ratio of solute to insoluble solids ranges from about 2:1 to about 0.25:1 “

and we will calculate the content of water solutes and water insoluble solids in 100 g of dry residue of soup concentrate.

Now, we will examine the ratio 2:1 (soluble solids: insoluble solids) disclosed by Glasser. This ratio means that out of 3 parts of total solids (2+1), 2 parts are soluble solids and 1 part is insoluble solids; therefore in 100 g of total solids 2/3 of the total will be soluble solids and 1/3 insoluble solids.

Soluble solids: $(2/3) \times 100 = 66.67\%$

Insoluble solids: $(1/3) \times 100 = 33.33\%$

If we take the second value disclosed by Glasser (0.25:1) and make the same calculation, we will obtain:

Soluble solids: $(0.25/1.25) \times 100 = 20\%$

Insoluble solids: $(1/1.25) \times 100 = 80\%$

In conclusion, in the Glasser patent the sentence at column 4, lines 13-17 can be rewritten as follows without altering the meaning:

However, it is essential that each soup concentrate of this invention be formulated with water solutes and water insoluble solids to the extent that the percentage in the dry residue ranges in percentage by weight as follows.

-water soluble solids from 66.67% to 20%

-water insoluble solids from 33.33% to 80%

Scenario B.

We will start from lines 17-20, column 4 of Glasser:

"The soup concentrates, in order to fall within the province of the invention, have a total moisture content ranging from about 40% to about 60%, water solutes ranging from about 20% to about 40%"

and we will calculate the water solutes (water soluble solids) and water insoluble solids contained in 100 g of dry residue.

As indicated by the Examiner, in order to calculate the water insoluble solids contained in 100g of dry residue, we will deduct the amount of water solutes (water soluble solids) in 100 g of dry residue.

So if: water solutes in the concentrate range in percentage by weight as follows: water solutes (water soluble solids) from 20% to 40%

And if: the soup concentrate in order to fall within the province of the invention has a total moisture content ranging from 40% to 60%

Therefore the dry residue in 100 g of soup concentrate ranges from 60% to 40%

So, there are 2 possibilities:

Possibility No 1: -water solutes 20g in 40g dry residue
 -water solutes 40g in 60g dry residue

Possibility No. 2: -water solutes 40g in 40g dry residue
 -water solutes 20g in 60g dry residue

Possibility No. 1:

 water solutes 20g in 40g dry residue
 water solutes 40g in 60g dry residue

In 40 g of dry residue there will be 20 g of water solutes (water soluble solids) and consequently, in 100g of dry residue there will be 50 g of water solutes. Therefore in 100 g of dry residue, the water insoluble solids will be 50 g ($100-50=50$)

In 60g of dry residue there will be 40 g of water solutes (water soluble solids), and consequently, in 100 g of dry residue , water solutes will be 66.67. Therefore, in 100 g of dry residue, the water insoluble solids will be 33.33 g ($100-66.67= 33.33\%$)

In conclusion water soluble solids and water insoluble solids in the dry residue range in percentage by weight as follows:

Water soluble solids from 66.67% to 50%

Water insoluble solids from 33.33% to 50%

Possibility No. 2:

 water solutes 40g in 40g dry residue
 water solutes 20g in 60g dry residue

Repeating the calculations executed for the 1st possibility, we will obtain:

In 40 g of dry residue there will be 40 g of water solutes (water soluble solids) and consequently, in 100g of dry residue there will be 100 g of water solutes. Therefore in 100 g of dry residue , the water insoluble solids will be 0 g ($100-100=0\%$)

In 60 g of dry residue there will be 20 g of water solutes (water soluble solids) , and consequently , in 100 g of dry residue , water solutes will be 33.33g. Therefore in 100 g of dry residue, the water insoluble solids will be 66.67 g ($100 - 33.33 = 66.67\%$)

In conclusion, water soluble solids and water insoluble solids in the dry residue range in percentage by weight as follows:

Water soluble solids from 100% to 33.33%

Water insoluble solids from 0% to 66.67%

In the Office Action, the Examiner has made some calculations using the B scheme using only Possibility No. 2 (see page 6, lines 1-6 in the Office Action).

CONCLUSIONS:

The range of soluble solids calculated by the Examiner is quoted in point (e), page 6:

"Thus, the percentage of soluble solids based on the percentage of dry residue is 33.3% (20/60) – 100(40/40)"

This range includes also the value of 100%, in this case meaning that the concentrate is without insoluble solids

In column 3, lines 8-12, of Glasser we read:

"The essence of the invention resides in the discovery that conventional soup ingredients which are water soluble and those which are water insoluble when, combined with a limited amount of water in correct proportions, will cooperate to...."

And in column 4, lines 13-17 of Glasser, we read:

"However it is essential that each soup concentrate of this invention be formulated with water solutes and water insoluble solids to the extent that the ratio of solute to insoluble solids ranges from about 2:1 to about 0.25:1 "

From these sentences it is obvious that Glasser describes products that always contain insoluble solids; therefore the value of 100% of soluble solids (0% of insoluble

solids) calculated by the Examiner is only an exercise of mathematics that does not match the text of the Glasser patent.

So, excluding the case of 100%, the segment of soluble solids considered by Glasser is the 33.33%-67.67% one (as calculated in Scenario B). This segment is outside of the range recited in the claims of the present application (70-82%).

In lines 10-12, page 10 of the Office Action dated November 1, 2006, the Examiner states the following:

“it is noted that Glasser’s recitation of ‘insoluble matter’ was not used [to] for the calculations since it does not reflect the amount of ‘insoluble solids’ in the composition”

Therefore, we have not made the calculations for the case (hereafter quoted) considered in lines 21-22 , column 4 (Glasser patent): *“and water insoluble materials ranging from about 10% to about 40% based on the weight of the concentrate.”*

Based upon the original disclosure, the Applicant has amended claims 24 and 25 to recite ranges which are not anticipated by the Glasser patent. Support for the ranges recited in claim 24 can be found in the original specification at page 12, lines 10-13 (18-30% of water-insoluble solids). The ranges recited in claim 25 are supported by the original disclosure at page 3, last line and at page 4, line 5 (20-30% water-insoluble solids). Support can also be found in original claims 2 and 3.

Having overcome the rejection based upon 35 U.S.C. 102(b) the Applicant now addresses the rejections made under 35 U.S.C. 103(a).

REJECTION UNDER 35 USC 103(a)

Claims 37-44 have been rejected under 35 U.S.C. 103(a) as being “unpatentable” over Glasser. Claim 31 has been rejected under 35 U.S.C. 103(a) as being “unpatentable” over Glasser as evidenced by Benefits. Claims 32, 35 and 36 have been rejected under 35 U.S.C. 103(a) as being “unpatentable” over Glasser in view of Terrytx.

All of these rejections are respectfully traversed. Reconsideration and withdrawal thereof are requested.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obviousness was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In*

re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

One skilled in the art realizes that non-homogenous mixtures are obtained by adding fat foodstuffs (i.e., oil, fat, cheeses) to tomato juice and to other known tomato products because known tomato products for use as such without dilution are not able to incorporate fat foodstuffs. One who has consumed tomato products has also noted that, at the end of the meal, fat residues are left in the dish separated from tomato residues. As stated in the present application at page 4, line 33 to page 5, line 3:

...Furthermore, the Applicant has found that the invention tomato products can unexpectedly incorporate, for example, by mechanical mixing, without showing any serum separation, animal and vegetable fats solid at room temperature, such (as) for example butter or margarine, and/or fats liquid at room temperature as for example vegetable oils, for example olive oil, and/or cheese having soft- or fresh-grain or hard-grain and grated.

The tomato products of the present invention are all ready for use as such, and when they are mixed with fat foodstuffs, leave in the dish homogeneous residues which are not distinguishable from the added foodstuff.

On page 8 of the Office Action, the Examiner cites two publications:

1. Benefits (The Benefits of Olive Oil)
2. Terrytx (Creamy Tomato Cheese Soup), 1999 Recipelink.com

The first publication only talks about the benefits of olive oil and does not appear to be relevant to the present claims.

The second publication teaches how to prepare a soup containing tomato (tomatoes skinned and chopped or canned chopped tomatoes), margarine and low fat cheese. Nothing is said that the margarine and the low fat cheese are incorporated in the soup. On the contrary, the publication states "Blend the soup until smooth in a liquidiser or food processor. Return to the

saucepan and add the cheese, stirring to melt." It is evident that the cheese melts and remains by itself, and is not incorporated.

It is respectfully submitted that the Examiner has not met the tests set forth by the Courts to support a *prima facie* case of obviousness. It is the Applicant's view that hindsight reconstruction is being used to allegedly assert obviousness against the claims in the present application. Having established novelty for claims 24 and 25, it is clear that the remaining claims should also be allowable. Considering the Glasser '809 patent for what it teaches, it is submitted that the Applicant has presented claims, which are not only novel but are also nonobvious with respect to the prior art. Simply stated, the claims herein are not disclosed as such in the Glasser patent and/or the combination of references cited by the Examiner. Hence, it logically follows that the dependent claims are patentable since hindsight reconstruction would be necessary to meet or render obvious the subject matter claimed by the Applicant.

CONCLUSION


The foregoing amendments and remarks are fully responsive to the Office Action of November 1, 2006. In addition, product-by-process claims 45-56 and process claims 57-68 are presented herewith for consideration. It is respectfully submitted that claims 45-68 are also in condition for allowance since the prior art does not teach or disclose the process embodied in the claims. Thus, favorable consideration and allowance of the claims are respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond C. Stewart, Reg. No. 21,066 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: March 1, 2007

Respectfully submitted,

By 

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Attachment: Verification of Translation
English Translation of Italian language paper of Carlo Leoni